



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,170	09/20/2000	Steven G. Reed	210121.475C7	8291

7590 12/09/2003

Jane E. R. Potter
Seed Intellectual Property Law Group PLLC
Suite 6300
701 Fifth Avenue
Seattle, WA 98104-7092

EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

Office Action Summary

Application No.

09/667,170

Applicant(s)

REED ET AL.

Examiner

James Martinell

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 9-15, and 17-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Art Unit: 1631

Claims 1-3, 9-15, and 17-39 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 14. In addition, applicants have elected SEQ ID NO: 440 for examination. It is noted that SEQ ID NO: 440 is not a species, but is separate and distinct from the other SEQ ID NOs mentioned in the claims. Thus, election of species practice does not apply to the instant application.

GenBank® Database Accession No. AB040875 is crossed off on form PTO-1449 submitted September 12, 2003 because it is a duplicate entry (see form PTO-1449 submitted March 13, 2003).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hillier et al (GenBank® Accession No. W00842 (4/18/96)). This rejection is repeated for reasons already of record (e.g., Office action mailed May 27, 2003, page 4). Applicants' argument and the amendment to the claims (response filed August 27, 2003, pages 13-14) are not sufficient to overcome this rejection because the DNA of Hillier et al would form a stable hybrid with a polynucleotide comprising SEQ ID NO: 440 under moderately stringent and under stringent conditions.

Claims 7 and 8 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by either one of Cheung et al (Genome Res. 9(10), 989 (1999)) or Williams et al (WO 9938972-A2). This rejection is repeated for reasons already of record (e.g., Office action mailed May 27, 2003, page 4). Applicants' argument and the amendment to the claims (response filed August 27, 2003, page 14) are not sufficient to overcome this rejection because the DNA of either reference would form a stable hybrid with a polynucleotide comprising SEQ ID NO: 440 under moderately stringent and under stringent conditions.

Claims 4-6 are allowable over the prior art of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1631

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028.

PLEASE NOTE THE NEW FAX NUMBER

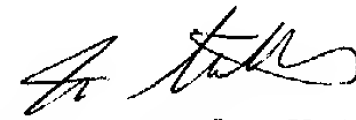
The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Art Unit: 1631

AFTER ABOUT JANUARY 12, 2004 USPTO OFFICES WILL BE MOVED

Offices of the USPTO will soon be moved. After the date in the header to this section Examiner Martinell may be reached at (571) 272-0719 and the fax phone number for his desktop workstation will be (571) 273-0719. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.



**James Martinell, Ph.D.
Primary Examiner
Art Unit 1631**